

REMARKS

Claims 1-7 are currently pending in the application. Claims 1-7 have been rejected under 35 U.S.C. § 103(a) as unpatentable over prior art. Claim 1 is currently amended to address the Examiner's objection to an informality in the wording of the claim. A parallel amendment is currently made to Claim 6, even though the Examiner did not raise an objection to similar wording in that claim. A parallel, purely formal amendment is also made to the specification by changing the term "that one of the titles" to "the title" at page 2, line 21. No new matter is added.

The claimed invention addresses the problem, encountered by users of music and video download services, of being required to spend too much time to find a single desired title among a very large number of titles. A cumbersome search process may make the acquisition of music or videos through downloading services less attractive to users by making the transaction overly time-consuming.

In order to address this problem, the claimed invention provides an online distribution system and method employing a search server 11, a data distribution server 12, and a personal terminal 10 to which the search server 11 is connectable. Identification information, which may include or be associated with a password, is transmitted from the personal terminal 10 in the course of a transaction. In one embodiment, a personal terminal 10 is connected to a search server 11 via the Internet 20, but other connection means may be employed in other embodiments. The search server 11 includes: a database for storing a plurality of titles; title search means for searching a database of stored titles; and subscription information storage means for storing a title search with identification information transmitted from the personal terminal 10 in connection with such title search. The data distribution server 12 includes distribution information storage means for storing distribution information, and the download terminal 14 includes identification information acquisition means. A first readout means generates a readout when a title stored in the subscription information storage means of the search server 11 corresponds to identification information inputted from outside. A second readout means generates a readout of distribution information (from the distribution information storage means of the data distribution server 12) corresponding to the title read out by the first readout means. A recording means records the distribution information read out by the second

readout means onto a recording medium. Alternatively, distribution information may be transmitted to a personal terminal 10 instead of being recorded onto a recording medium. (Claims 1, 4, 6, and 7)

The claimed invention may employ settlement means for performing a settlement in regard to the transmission of the distribution information for the personal terminal 10. (Claims 2 and 5)

The claimed invention may further employ a cache server 13 in which part of the distribution information storage means of the data distribution server 12 is stored in advance. In one embodiment, a cache server 13 is connected to a data distribution server 12 via a private line 21, but other connection means may be employed in other embodiments. When a cache server 13 is employed, a download terminal 14 may acquire the distribution information from the cache server 13 if the distribution information of the title corresponding to the identification information stored in the subscription storage means of the search server 11 is stored in the cache server 13. If, however, such distribution information is not stored in the cache server 13, the download terminal 14 acquires the distribution information from the distribution storage means of the data distribution server 12. (Claim 3)

Claims 1, 2, 3, and 6 have been rejected pursuant to 35 U.S.C. § 103(a) as unpatentable over Canadian Published Patent Application No. 2,225,190 to Oakley in view of official notice of certain technical facts asserted without citation of any reference work. Claims 4, 5, and 7 have been rejected pursuant to 35 U.S.C. § 103(a) as unpatentable over Oakley in view of U.S. Patent No. 6, 247,130 to Fritsch and further in view of, again, official notice of certain technical facts asserted without citation of any reference work.

Applicant respectfully traverses such rejections, as discussed below.

Claims 1, 2, 3, and 6

The Examiner rejected Claims 1, 2, 3, and 6 pursuant to 35 U.S.C. § 103(a) as unpatentable over Oakley (including matters asserted to be disclosed therein by inherency) and in view of official notice of certain technical facts. Applicant respectfully traverses the Examiner's assertion of disclosure by inherency and the taking of official notice on the basis that the Examiner's comments in this regard constitute impermissible hindsight as well as an improper assertion of technical fact in an area of esoteric technology without support by citation of any reference work.

See M.P.E.P. § 2144.03 (citing *In re Ahlert*, 424 F.2d 1088, 1091, 165 U.S.P.Q. 418, 422-21 (C.C.P.A. 1970)).

With regard to Claims 1 and 6, the Examiner contends that Oakley describes a search server comparable to the search server of the claimed invention. However, unlike the “end-point” or “remote servers” described by Oakley in the passages cited by the Examiner (Oakley at page 5, lines 16-30; page 10, lines 7-14), search server of Claims 1 and 6 does not have a direct role in the step of downloading music for the customer. In addition, passages from Oakley cited by the Examiner fail to describe a server with characteristics of the search server of Claims 1 and 6, including, but not limited to, (a) a database for storing a plurality of titles, (b) title search means for searching a database of stored titles, and (c) subscription information storage means for storing a title search with identification information transmitted from the personal terminal in connection with such title search. The Examiner concedes that Oakley does not disclose a personal terminal such as the personal terminal of Claims 1 and 6. Recognizing the deficiency of Oakley in this regard, the Examiner relies on official notice unsupported by citation of any reference work to provide the missing features in an exercise of impermissible hindsight, as noted in the traversal above. The Examiner has also stated that “Oakley discloses (by inherency) that said search server includes a database for storing a plurality of songs or other works for distribution information.” (Office Action at page 4) If that is the case, however, then Oakley is clearly distinguishable from the claimed invention, since the search server of Claims 1 and 6 has a database for searching titles, while the audio or video content corresponding to such titles (the “distribution information”) is to be found with the data distribution server and not with the search server.

The Examiner has taken the view that Oakley describes a data distribution server comparable to the data distribution server of Claims 1 and 6. To the extent the data distribution server of Claims 1 and 6 has audio content (the “distribution information”) and a recording means for recording such content onto a recording medium, it is clear that those functions would be performed in connection with the system and method described by Oakley. This is not surprising, since both Oakley and the claimed invention involve the downloading of digital data onto a recording medium for distribution. There is no indication in Oakley, however, that such downloading and recording functions would be performed in connection with a

second readout, as in Claims 1 and 6. In addition, the Examiner's argument appears to be internally inconsistent and lacking in specificity because the "remote server" of Oakley is analogized not only to the search server but also to the data distribution server of Claims 1 and 6.

The Examiner further contends that Oakley describes a download terminal comparable to the download terminal of Claims 1 and 6. The passage from Oakley cited by the Examiner indicates that the Examiner has found, in the download terminal, another aspect of the claimed invention which, like the search server of the claimed invention, may be analogized to the "remote server" or the "end point" of Oakley. Unlike the referenced features of Oakley (Oakley at page 5, lines 16-30), however, the download terminal of Claims 1 and 6 includes means for acquiring identification information from the personal terminal via the search server. In addition, the Examiner's argument again appears to be internally inconsistent and lacking in specificity in that the Examiner has cited the same passage from Oakley as describing features analogous not only to the search server but also to the download terminal of Claims 1 and 6 (Oakley at page 5, lines 16-30).

With regard to Claim 2, the Examiner took the view that the settlement means described in that claim is not patentable over Oakley because Oakley describes means for making payment. Unlike Claim 2, however, Oakley does not discuss settlement means to be employed in connection with a download terminal or a personal terminal. In addition, because Claim 2 is dependent from Claim 1, arguments as to why Claim 1 is patentable over prior art also apply to Claim 2 and are incorporated herein by reference.

With regard to Claim 3, the Examiner took the view that the cache server described in that claim is analogous to unspecified features of Oakley to be found therein at page 3, lines 8-13; page 5, lines 16-30; and page 11, lines 21-27. Unlike Claim 3, however, Oakley does not discuss the caching of data via a cache server to be employed in connection with a data distribution server. In addition, because Claim 3 is dependent from Claim 1, arguments as to why Claim 1 is patentable over prior art also apply to Claim 3 and are incorporated herein by reference.

Applicant thus traverses the rejection of Claims 1, 2, 3, and 6 for reasons explained above.

Claims 4, 5, and 7

The Examiner rejected Claims 4, 5, and 7 pursuant to 35 U.S.C. § 103(a) as unpatentable over Oakley (including matters asserted to be disclosed in Oakley by inherency), in view of Fritsch and further in view of official notice of certain technical facts. As above, Applicant respectfully traverses the assertion of disclosure by inherency and the taking of official notice on the basis that the Examiner's comments in this regard constitute impermissible hindsight as well as an improper assertion of technical fact in an area of esoteric technology without support by citation of any reference work. *See* M.P.E.P. § 2144.03 (citing *In re Ahlert*, 424 F.2d 1088, 1091, 165 U.S.P.Q. 418, 422-21 (C.C.P.A. 1970)). In addition, the foregoing discussion of Claims 1, 2, 3, and 6 is incorporated herein by reference.

With regard to Claims 4 and 7, Applicant respectfully suggests that the Examiner may have misapprehended the claimed invention. The Examiner apparently views Claims 4 and 7 as permitting a user to employ a personal terminal to access a data distribution server with a search server acting as a mere conduit to the data distribution server. According to the claimed invention, however, and Claims 4 and 7 in particular, the search server employs a database for storing a plurality of titles of distribution information, title search means for searching the titles stored in said database, and subscription information storage means for storing the title search out by said title search means. Thus, even if, *arguendo*, "it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the personal terminal be connected to the data distribution server through said search server, for the obvious advantage of avoiding the expense and difficulty of maintaining two libraries of the same songs, sound bites, etc." (Office Action at 6-7), it is not a principal object of the claimed invention to avoid expense or difficulty involved in maintaining two libraries. To the contrary, it is an object of the claimed invention "to provide an online distribution system and method by which the time required for a downloading procedure in a shop can be performed in a shot time." (Application, page 1, line 24, through page 2, line 1) One means by which the object of saving time is accomplished in the claimed invention, including Claims 4 and 7, is to employ a search server with a database to facilitate searching for titles available for downloading from a separate data distribution server. A searchable database associated with a search server is, however, not present in or contemplated

by Oakley or Fritsch. Furthermore, the claimed invention does not seek to avoid maintaining duplicate copies of material. It is, in fact, the function of the cache server 13 to store duplicate copies of certain distribution information so that such distribution information may be downloaded via the download terminal 14 without accessing the data distribution server 12.

Applicant respectfully traverses the Examiner's contention that "[i]t is arguable whether the public kiosk disclose[d] by Oakley can be considered 'the personal terminal' [of Claims 4 and 7]." Since it is the essence of a "public kiosk" that it is public, while it is the essence of a "personal terminal" that it is personal, there does not appear to be significant room for argument that they are the same. Recognizing the deficiency of Oakley in this regard, the Examiner relies upon Fritsch to supply the personal terminal. While the referenced passage from Fritsch states that "[c]onsumers may access the web site via a personal computer or any other wired or wireless Internet access device" (Fritsch, Specification at column 2, line 66 through column 3, line 1), Fritsch does not provide for such Internet access device to be employed to access a search server or a data distribution server. In contrast to Fritsch, there is nothing in the claimed invention to prevent a telephone handset connected to a search server via the public telephone network without the use of a modem from acting as a personal terminal. Furthermore, while Fritsch may employ a database of "digitized songs, text associated with each song such as track name, album name, artist name, lyrics, etc., image data, graphics, etc." (Fritsch, Specification at column 3, lines 16-19), Fritsch does not employ a search server distinct from a data distribution server and does not employ either a database storing a plurality of titles of distribution information or a means of searching titles stored in such a database, as in Claims 4 and 7 of the claimed invention. Finally, Fritsch is expressly limited to the Internet, while the claimed invention may employ networks other than the Internet.

With regard to Claim 5, the Examiner took the view that the settlement means described in that claim is not patentable over Oakley in view of Fritsch because both Oakley and Fritsch describe means for making payment. Unlike Claim 2, however, Oakley does not discuss settlement means to be employed in connection with a download terminal or a personal terminal. Meanwhile, Fritsch discusses settlement means expressly limited to Internet transactions, while Claim 5 may employ networks other than the Internet. Finally, because Claim 5 is dependent from Claim 4,

arguments as to why Claim 4 is patentable over prior art also apply to Claim 5 and are incorporated herein by reference.

Applicant thus traverses the rejection of Claims 4, 5, and 7 for reasons explained above.

Conclusion

In view of the foregoing, it is respectfully requested that the application be reconsidered, that Claims 1-7 be allowed, and that the application be passed to issue. Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

A provisional petition is hereby made for any extension of time necessary for the continued pendency during the life of this application. Please charge any fees for such provisional petition and any deficiencies in fees and credit any overpayment of fees for the petition or for entry of this amendment to Attorney's Deposit Account No. 50-2041 (Whitham, Curtis & Christofferson P.C.).

Respectfully submitted,



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